



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masahiko NAKANO

Group Art Unit: 3661

Application No.: 10/619,034

Examiner: M. ZANELLI

Filed: July 15, 2003

Docket No.: 116604

For: NAVIGATION APPARATUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal filed herewith. Applicant respectfully requests review of the Final Rejection mailed March 23, 2005 in the above-identified application.

Claims 1-14 are pending in this application. No amendments are being filed with this request. This review is requested for the following reasons.

First, Applicant has previously explained that any permissible combination of Ihara, Shimizu, Walker and/or Berstis does not teach or suggest a navigation apparatus including a "display control unit for determining whether or not a user selects one of the main points and displaying a real image showing a surrounding of a selected main point on the display screen on a basis of position information of the selected main point and real image data corresponding to position coordinates, when the second display control unit determines that the user selects one of the main points, wherein the real image includes at least one of an aerial photograph and a satellite photograph," as recited in independent claim 1, and similarly

recited in independent claim 2. As discussed below, the Examiner has not responded to the points raised by Applicant in this regard.

Second, Applicant has previously explained that any permissible combination of Ihara, Shimizu, Walker and/or Berstis does not teach or suggest a navigation apparatus including "a first selection unit for selecting a point, a real image of which is to be displayed on the display screen, from among main points on a route to the destination on a basis of a movement state of the vehicle, wherein the real image includes at least one of an aerial photograph and a satellite photograph," as recited in independent claim 3. As discussed below, the Examiner has not responded to the points raised by Applicant in this regard.

I. The Asserted Combination of Ihara and Shimizu is Improper

A. Even if Combined to Combine Ihara and Shimizu to Result in the Claimed Combination of Features

Ihara discloses that a route, which includes created or edited marks O, may be displayed on a map image or another type of background image. See paragraph [0052] of Ihara. When the main points O are selected by a user, an associated object information I, e.g., photographs, may be displayed. See Figs. 1, 3B and paragraphs [0017] and [0044]-[0046]. The March 23 Final Rejection admits that "Ihara merely discloses that photographs may be displayed corresponding to the mark on the route." See page 3, lines 2-3 of March 23, 2005 Final Rejection. However, the March 23 Final Rejection asserts that Shimizu remedies the deficiencies of Ihara.

Specifically, the Final Rejection asserts that "Shimizu shows an aerial or satellite photograph encompassing a point along a displayed navigation route" and that it would have been obvious to one of ordinary skill in the art to apply the aerial or satellite photograph of Shimizu to the navigation apparatus of Ihara because use of aerial or satellite photographs for the purposes of navigation are well-known in the art. See page 3, lines 5-7 of March 23,

2005 Final Rejection. However, even if combined, the references would not have resulted in the claimed combination of features.

As Applicant explained previously, Shimizu teaches displaying a mark based on a current position of a movable body. See col. 2, lines 3-12. Further, Shimizu teaches displaying a mark on different backgrounds such as an aerial photograph or a map image. See Fig. 6A-6B and col. 6, lines 21-50. However, Shimizu does not teach or suggest that the aerial photograph is displayed based on a user-selected point provided on a route. For example, the aerial photograph of Shimizu is displayed based solely on a user selection to display the aerial photograph as a background image. The aerial photograph is not displayed based on position information of a user-selected point.

Because neither Ihara nor Shimizu teach or suggest displaying an aerial photograph based on a selected point provided on a route, they would not have resulted in the combination of features, even if combined. The Examiner has not offered a rebuttal to this point.

B. There Would Have Been No Motivation to Combine Ihara and Shimizu to Result in the Claimed Combination of Features, Even if Ihara and Shimizu Could Be Combined to Include Other Features

As Applicant explained previously, because neither Ihara nor Shimizu teach or suggest displaying an aerial photograph based on and/or associated with user selection point provided on a route displayed on a background image, there would have been no motivation to include such a feature. Even if Shimizu and Ihara were combined to include other features, there would have been no motivation to combine the background aerial photograph as taught by Shimizu in the navigation device of Ihara to achieve the features recited in claims 1-3. The Examiner has not responded to this point.

II. The Asserted Combination of Ihara, Shimizu, Walker and Berstis is Improper

Under MPEP §2141.03, prior art references must be considered in their entirety, including disclosures that teach away from the claims.

The Office Action admits that one would not have found it obvious to modify Walker and Berstis with the teachings of Shimizu. See page 4, no. 6 of the March 23, 2005 Office Action. Thus, Walker and Berstis, considered in their entirety, include disclosures that teach away from a combination with the teachings of Shimizu. Because the Office Action admits that Berstis and Walker would not have suggested the use of aerial or satellite photographs, it would not have been obvious for one of ordinary skill in the art to modify the teachings of Ihara and Shimizu in view of Walker and Berstis. The Examiner has not responded to this point.

For at least the reasons discussed above, no suggestive reason exists in either the teaching of Ihara, Shimizu, Walker or Berstis to combine the teachings of the references to achieve the navigation apparatus of claims 1-3.

III. Conclusion

For at least the reasons discussed above, claims 1-3 would not have rendered obvious by Ihara, Shimizu, Walker and/or Berstis. Claims 4-14 variously depend from claims 1-3, and thus also would not have been rendered obvious by Ihara, Shimizu, Walker and/or Berstis for at least the reasons set forth above and the reasons in the June 23, 2005 Request for Reconsideration After Final Rejection, as well as for the additional features they recite. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-14 are earnestly solicited.

Should the panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:HNM

Attachment:
Notice of Appeal

Date: July 25, 2005

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